

REMARKS

The Examiner is thanked for the indication that claims 5-6, 11-12, and 23-24 are objected to but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-4, 6-11, 13-16, 18-22, and 24 are pending in the application. Claims 1, 7, 13, and 19 are independent. By the foregoing Amendment, Applicants have amended claims 1, 6-7, 11, 13, 18-19, and 24 and have canceled claims 5, 12, 17, and 23. It is believed that these changes introduce no new matter and their entry is respectfully requested.

No Summary of the Invention in the Specification

In paragraph 2 of the Office Action, the Examiner requested that Applicants provide a "Brief Summary of the Invention" to the application. However, Applicants would like to kindly point out that both the M.P.E.P. and 37 C.F.R. §1.73 do not require the presence of a "Summary of the Invention" in a patent application. They merely indicate where in the application the "Summary of the Invention" should be placed if Applicants were to elect to include one. In particular, 37 C.F.R. §1.73 only states that "[a] brief summary of the invention ... should precede the detailed description." 37 CFR § 1.73 does not state "must" or "shall." Accordingly, Applicants have elected not to include a "Summary of the Invention" as this is within the discretion of Applicants.

Rejection of Claims 13-18 Under 35 U.S.C. §101

In paragraph 4 of the Office Action, the Examiner rejected claims 13-18 under 35 U.S.C. §101 as being directed to non-statutory subject matter. In particular, the Examiner states that claims 13-18 are not limited to tangible embodiments because, in view of the Specification at page 12, lines 4-6, the medium is not limited to tangible embodiments, instead being defined as including intangible embodiments (e.g., computer data signal embodied in a carrier wave). Applicants respectfully traverse the rejection.

MPEP §2106.II.A provides that in order for a signal propagation claim to be statutory, it must be a transformation of data providing a useful, tangible, and concrete result

(citing *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. Jul. 23, 1998)). MPEP §2107.02.IV provides that to properly reject a claim under 35 U.S.C. §101, an Examiner must (1) make a *prima facie* showing that the claimed invention lacks utility and (2) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing. Thus, in order for the Examiner to make out a *prima facie* case of lack of utility, the Examiner must show that the claims at issue are not a ***transformation of data providing a useful, tangible, and concrete result***, and the Examiner must also support this showing with evidence.

Applicants respectfully submit that the Examiner has failed to meet this burden. For example, claim 13, and claims 14-18 by dependency, recites in pertinent part a “computer data signal embodied in a carrier wave for communicating between a first device and a second device, wherein the first and second devices communicate with each other over a bus, the computer data signal comprising....” Applicants respectfully submit that the computer data signal recited in claim 13, and claims 14-18 by dependency, is a transformation of data providing a useful, tangible, and concrete result. For example, the computer data signal recited in claim 13, and claims 14-18 by dependency, according to at least one embodiment may transform bits of “ones” and “zeros” into frames embodied in the tangible, machine-readable, carrier wave, which devices use to communicate with each other and which results in synchronization of channels on a bus. Accordingly, Applicants respectfully submit that claim 13, and claims 14-18 by dependency, is statutory subject matter, and respectfully request that the Examiner reconsider and remove the rejection to them.

Rejection of Claims 1-4, 7-10, and 13-22 Under 35 U.S.C. § 103(a)

In paragraph 6 of the Office Action, the Examiner rejected claims 1-4, 7-10, and 13-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,436,897 to Cook (hereinafter “Cook”) in view of U.S. Patent No. 6,374,360 to Keeth et al. (hereinafter “Keeth”). To establish a *prima facie* case of obviousness, an Examiner must show three things: (1) that there is some suggestion or motivation to modify a reference or combine reference teachings to arrive at the claimed invention, (2) that there must be a reasonable expectation of success, and (3) that the references teach or suggest each and every element of the claimed invention. (MPEP §2143) Applicants respectfully traverse the rejection.

Although Applicants believe claim 1 to be patentable as written, Applicants have amended claim 1 to incorporate the subject matter of claim 5, which the Examiner indicated would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Applicants respectfully submit that claim 1 is now in condition for allowance. And respectfully request that the Examiner reconsider and remove the rejection to it.

Although Applicants believe claim 7 to be patentable as written, Applicants have amended claim 7 to incorporate the subject matter of claim 12, which the Examiner indicated would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Applicants respectfully submit that claim 7 is now in condition for allowance. And respectfully request that the Examiner reconsider and remove the rejection to it.

Applicants have amended claim 13 to incorporate the subject matter of claim 17. Applicants respectfully submit that claim 13 is now in condition for allowance. And respectfully request that the Examiner reconsider and remove the rejection to it.

Although Applicants believe claim 19 to be patentable as written, Applicants have amended claim 19 to incorporate the subject matter of claim 23, which the Examiner indicated would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Applicants respectfully submit that claim 19 is now in condition for allowance. And respectfully request that the Examiner reconsider and remove the rejection to it.

CONCLUSION

Applicants submit that all grounds for rejection have been properly traversed or accommodated, and that the application is in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,
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